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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/068,533 | 02/05/2002 | Robert H. Dahla | CB-11-1 | 9992 |

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| EXAMINER | |
|---|---|
| PEFFLEY, MICHAEL F | |
| **ART UNIT** | **PAPER NUMBER** |
| 3739 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 04/11/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/068,533 | DAHLA ET AL. | |
| | Examiner | Art Unit | |
| | Michael Peffley | 3739 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24 and 26-52* is/are pending in the application.

4a) Of the above claim(s) *1-11,13-21 and 27-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12,22-24,26,51 and 52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 September 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/7/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's response of March 7, 2007 has been fully considered by the examiner. It is noted that claim 25 is canceled, and claims 1-11, 13-21 and 27-50 remain withdrawn as being directed to a non-elected invention.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Terminal Disclaimer***

The terminal disclaimer filed on March 7, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Serial Number 10/072,599 has been reviewed and is NOT accepted. Applicant has provided the wrong filing date of February 2, 2002 for the '599 application. The correct filing date is February 5, 2002.

The terminal disclaimer filed on March 7, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,837,888 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings filed September 25, 2006 did not have the label "Replacement Sheet" pursuant to 37 CFR 1.21(d). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are

required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

Claims 12, 22, 23, 51 and 52 are rejected under 35 U.S.C. 103(a) as being anticipated by Edwards et al (5,507,743) in view of the teaching of McGaffigan et al (5,873,877).

Edwards et al disclose an ablation device comprising an elongate probe (22 – Figure 4a) having active and return electrodes (12,14) at the distal end. Column 5, lines 15-16 disclose the return electrode as having 4 or fewer coils, and column 1, lines 58-60 disclose that temperatures of greater than 45 degrees Celcius are used to treat tissue. The specific energy level necessary to create such a temperature in tissue is deemed to be obvious to one of ordinary skill in the art. The step of providing the electrodes to tissue and delivering energy from the active to the return electrode is fully supported in the Edwards et al disclosure. The return electrode having the turns inherently has a larger surface area than the active electrode since it is longer. The Edwards et al return electrode has gaps through which a fluid may flow. Edwards et al further teach that an aspiration means may be provided to aspirate tissue ablated with the needle electrodes (col. 4, lines 1-8), but fails to specifically show the aspiration means on the probe.

McGaffigan et al disclose an analogous probe that includes a plurality of electrodes deployable from the probe for the ablation of tumor tissue. In particular, McGaffigan et al teach that it is known to provide such a device with a suction port (73) for aspirating tissue being treated with the electrodes (col. 8, lines 1-5).

To have provided the Edwards et al device with an aspiration port on the probe handle for aspirating tissue ablated with the needle electrodes would have been an obvious modification for one of ordinary skill in the art in view of the teaching of McGaffigan et al.

Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al ('743) and McGaffigan et al ('877) in view of the teaching of Stevens-Wright et al (5,715,817).

The combination of the McGaffigan et al teaching with the Edwards device has been previously addressed. Edwards et al fail to specifically disclose the use of multiple lumens for providing the active and return electrodes to the distal end of the device.

Stevens-Wright et al disclose an electrosurgical device, and specifically teach that electrode leads may be provided through individual channels (see Figures 9-13) and connected to electrodes.

To have provided the Edwards et al device, as modified by the teaching of McGaffigan et al, with multiple lumens for supporting the multiple electrodes/leads provided at the distal end of the device would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Stevens-Wright et al.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al ('743), McGaffigan et al ('877) and Stevens-Wright et al ('817) and further in view of the teaching of Imran et al ('554).

Edwards et al fail to specifically disclose making the catheter probe from a polyurethane extrusion. Again, the examiner maintains that the use of any well-known materials for making probes would be an obvious design consideration.

Imran et al, as addressed previously, disclose a probe device very much analogous to the Edwards et al probe. In particular, Imran et al disclose that the probe is made from a polyurethane extrusion (col. 2, line 64 through col. 3, line 2).

To have fabricated the Edwards et al device from any well known flexible polymer, including an extruded polyurethane, would have been an obvious design consideration for one of ordinary skill in the art, particularly since Imran et al teach that it is known to make analogous probes from such a material.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 22-24, 26, 51 and 52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 10/072,599. Although the conflicting

claims are not identical, they are not patentably distinct from each other because the use of a spacer to maintain electrical separation of the active and return electrodes is deemed an obvious design consideration for one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant's arguments filed March 7, 2007 have been fully considered but they are not persuasive.

Applicant contends that Edwards ('743) fails to disclose a needle electrode extending beyond the coiled electrode and specifically indicates that Figures 1A and 5 show the needle electrode as being coextensive with the coiled electrode. The examiner maintains that Figures 1A and 5 are perspective views that make the identification of the ends of the electrodes difficult to clearly ascertain. Figures 1B and 1C show close up views of the electrodes whereby the central needle electrode clearly extends beyond the coiled electrode. As such, the examiner maintains the rejections are tenable.

With regard to claims 24 and 26, applicant has only asserted that the Edwards and McGaffigan references do not teach the needle electrode extending beyond the coiled electrode and these claims are therefore allowable since they depend from allowed claims. As asserted above, Edwards is deemed to teach the claimed electrode arrangement, and the rejection of claims 24 and 26 is maintained.

## *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Peffley
Primary Examiner
Art Unit 3739

mp
April 4, 2007